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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,691	02/14/2002	H. Michael Shepard	016930-000630US	2435
20350	7590	10/06/2003		
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER NGUYEN, DAVE TRONG	
			ART UNIT	PAPER NUMBER
			1632	9

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/076,691

Applicant(s)

SHEPARD ET AL.

Examiner

Dave T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Inventions 1-4: embraces by claim 3 or claim 18, wherein each of the inventions is directed to a transduction method of employing a suitable retroviral vector to transduce a pathologic hyperproliferative mammalian cell with a particularly named tumor suppressor gene, e.g., wild type p53 gene, retinoblastoma gene, RB, Wilm's tumor gene WT1, and colon carcinoma DCC, classifiable in class 424, subclass 93.2.

Claim 1 and 18 are identified as a linking claim for inventions 1-4.

Should any of Inventions 1-4 be elected, a further group restriction required between an *in vivo* gene therapy invention and an *ex vivo* gene therapy invention:

Invention 1-4/A, claim 12, drawn to an *ex vivo* therapy invention, wherein a particular named tumor suppressor gene as listed in claim 3 is employed, classifiable in class 424, subclass 93.21.

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Invention 1-4/B, claims 13, 16-24, drawn to an *in vivo* gene therapy invention, wherein a particular named tumor suppressor gene as listed in claim 3 is employed, classifiable in class 424, subclass 93.2.

Claims 1-11, 14-15 are identified as linking claims for inventions 1-4/A and 1-4/B.

Note that the restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), as listed above. Upon the allowance of the linking claims, the restriction requirement as to the linked invention shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such (claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims or the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because of the following reasons:

Inventions 1-4 are distinct because each of inventions 1-4 is directed to treatment method of using a particularly named tumor suppressor gene, wherein a search and examination of one does not necessarily overlap with another one. Further, the claimed tumor suppressor genes are structurally and/or functionally distinct. Even if any of inventions 1-4 be elected, the elected invention is further required to restricted between *ex vivo* gene therapy and *in vivo* gene therapy because *ex vivo* gene therapy and *in vivo* gene therapy are directed to materially distinct steps and are expected to generated distinct functional effects.

Should any of invention 1-4/A and 1-4/B be elected, a Species Restriction to one of the following inventions is required under 35 U.S.C. 121:

The presently pending claims for each of the elected invention are generic to a plurality of disclosed patentably distinct species comprising:

- A specific species of pathologic hyperproliferative mammalian cells as listed in claim 7 or 21.

Applicant is further required under 35 U.S.C. 121 to elect a single disclosed species from the respective claims as listed and cited above, even though this requirement is traversed. A search of one specific species of pathologic hyperproliferative mammalian cells does not necessarily overlap with another species, since the listed cells are structurally and morphologically distinct with one another.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

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showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these species are structurally distinct, and because a search of one does not necessarily overlap with that of another species, it would be unduly burdensome for the examiner to search and/or consider patentability of all of the claims as presently pending.

Applicant is advised that the response to this requirement to be complete must include an species election of the invention to be examined even though the requirement be traversed.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their divergent subject matter, fall into different statutory classes of invention, and are separately classified and searched, it would be unduly burdensome for the examiner to search and examine for patentability of all of the claimed inventions, and thus, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if

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one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Dave Nguyen* whose telephone number is **(703) 305-2024**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Deborah Reynolds*, may be reached at **(703) 305-4051**.

Any inquiry of a general nature or relating to the status of this application should be directed to the *Group receptionist* whose telephone number is **(703) 308-0196**.

Dave Nguyen
Primary Examiner
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DAVE T. NGUYEN
PRIMARY EXAMINER